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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,784	02/28/2005	Jan Balzarini	50304/061001	8526

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EXAMINER	
MOHAMED, ABDEL A	
ART UNIT	PAPER NUMBER
1654	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/525,784	BALZARINI ET AL.	
	Examiner	Art Unit	
	Abdel A. Mohamed	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2005*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *23-38* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The preliminary amendment filed 02/28/05 is acknowledged, entered and considered. In view of Applicant's request claims 1-22 have been cancelled and clams 23-38 have been added. Claims 23-38 are now pending in the application.

RESTRICTION REQUIREMENT

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-28, drawn to a glycopeptide antibiotic or derivative thereof according to formula I, II, and III and a composition for separate, combined or sequential use in the treatment or prophylaxis of anti-viral infections thereof.

Group II, claim(s) 29-36, drawn to a method for preventing or treating a viral infection in a subject by administering glycopeptide antibiotics or derivatives thereof.

Group III, claim(s) 37 and 38, drawn to a method of screening or selecting antiviral compounds or antiviral glycopeptide antibiotics for determining the antiviral and the antibacterial activity and the cell toxicity thereof.

The inventions listed as Groups I, II and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The

glycopeptide antibiotic or derivative thereof according to formula I, II and III and compositions thereof of Group I and the methods of Groups II and III are different methods directed to a method for preventing or treating a viral infection by administering glycopeptide antibiotics and derivatives thereof (Group II) and a screening method for determining the antiviral activity and cell toxicity (group III). Thus, the composition comprising the glycopeptide antibiotics and derivative thereof of Group I and the two methods (Groups II and III) do not correspond to the same technical features and are not connected in design, operation or effect because they differ in structure, formulation, method steps, parameters and reagents used, and as such, the composition and the methods as grouped are different from each other because they represent different technical features and different endeavors. Hence, the composition of Group I comprising a glycopeptide antibiotics and derivatives thereof have different structures, functions and different effects while Group II is directed to a method for preventing or treating a viral infection and Group III is directed to assay method (i.e., screening or selecting) for determining the antiviral and the antibacterial activity and cell toxicity thereof. Thus, the Groups require different patent and literature search and a reference teaching a composition comprising a glycopeptide antibiotic and derivative thereof will not teach the method for preventing or treating a viral infection nor the assay method for screening or selecting antiviral compounds or antiviral glycopeptide antibiotics for determining antiviral activity and cell toxicity and *vice versa*. Therefore, Groups I, II and III do not share the same technical features, the inventions do not relate to a single inventive concept.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species I, formula I listed in claims23 and 32.

Species II, formula II listed in claims 23 and 32.

Species III, formula III listed in claims23 and 32.

Species IV, virus families listed in claims 28, 34 and 35.

Subspecies a) viruses listed in claim 36.

Species V, antibiotics listed in claim 31.

The species and subspecies listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species and subspecies lack the same or corresponding special technical features for the following reasons: The species are independent or distinct because within each of the species groups, the separate species are not coextensive and require separate searching. For example, a composition for use in the treatment or prophylaxis of antiviral infection of claim 28 encompasses a wide range of viral families. A reference teaching one species does not necessarily render the other species obvious. Thus, the various species and subspecies require different patent and literature search. Therefore, the species and subspecies cited above do not share the same technical features, the inventions do not relate to a single inventive concept.

Thus, Applicant is required, in reply to this action, to elect a single disclosed species for prosecution on the merits for each of the species groups I through V (elect a subspecies for Species Group IV), and a species from the elected subspecies group in Species Group IV to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 24-28, 29, 30 and 33 are generic.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species and subspecies may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species and subspecies are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species and subspecies to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (571) 272 0955. The examiner can normally be reached on First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tsang Cecilia can be reached on (571) 272 0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jon Weber
Supervisory Patent Examiner

AAM Mohamed/AAM
March 28, 2007